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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,381	02/10/2004	Motoki Kato	247987US	9523
22850 7590 04/16/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER DUNN, MISHAWN N				
ART UNIT		PAPER NUMBER		
2621				
NOTIFICATION DATE		DELIVERY MODE		
04/16/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/774,381

Applicant(s)

KATO ET AL.

Examiner

MISHAWN DUNN

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-11 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-11 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, filed 3/12/09, with respect to the rejection(s) of claim(s) 1, 2, 6-11, and 14 under U.S.C. 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 11 is rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent and recent Federal Circuit decisions indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim recites a series of steps or acts to be performed, the claim neither transforms underlying subject matter nor is positively tied to another statutory category that accomplishes the claimed method steps, and therefore does not qualify as a statutory process. For example the method including steps of receiving, generating and recording is not of sufficient breadth that it would be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 8, 9, 11, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagata et al. (US Pub. No. 2004/0047612) in view of Terasaki et al. (US Pat. No. 5,684,768).

5. Consider claim 1. Nagata et al. teaches a transport stream recording apparatus comprising: an input unit operable to input a transport packet constituting said transport stream (fig. 10); and a recording unit operable to record said program sequence information along with said transport stream (pg. 7, para. 0120 and pg. 8, para. 0149).

Nagata et al. does not teach a generator operable to generate program sequence information indicative of an interval in which a coding attribute of each video and/or audio elementary stream in said transport stream does not change.

However, Terasaki et al. teaches a generator operable to generate program sequence information indicative of an interval in which a coding attribute of each video and/or audio elementary stream in said transport stream does not change (abstract; col. 5, lines 10-25; figs. 1-3).

Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made to use, to generate program sequence information indicative of an interval in which a coding attribute of each video and/or audio

elementary stream in said transport stream does not change, in order to randomly access the data properly.

6. Consider claim 2. Nagata et al. teaches a transport stream recording apparatus according to claim 1, wherein said generator generates program sequence information indicative of the sequence of transport packets that includes no PCR_PID discontinuity (pg. 8, para. 0148).

7. Consider claim 8. Nagata et al. teaches a transport stream recording apparatus according to claim 5, wherein said coding attribute includes audio coding method (pg. 8, para. 0149).

8. Consider claim 9. Nagata et al. teaches a transport stream recording apparatus according to claim 5, wherein said coding attribute includes audio component type (pg. 8, para. 0149).

9. Claims 11 and 14 are rejected using similar reasoning as the corresponding claims above.

10. Claims 6, 7, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagata et al. (US Pub. No. 2004/0047612) in view of Terasaki et al. (US Pat. No. 5,684,768) in further view of Fukuda et al. (US Pat. No. 6,856,759).

11. Consider claim 6. Nagata et al. and Terasaki et al. teach all claimed limitations as stated above, except wherein said coding attribute includes video frame frequency.

However, Fukuda et al. teaches wherein said coding attribute includes video frame frequency (col. 16, lines 9-14).

Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made to use, to include video frame frequency in the coding attribute, in order to properly reproduce the video images in a manner that represents the recorded signal.

12. Consider claim 7. Nagata et al. and Terasaki et al. teach all claimed limitations as stated above, except wherein said coding attribute includes aspect ratio.

However, Fukuda et al. teaches except wherein said coding attribute includes aspect ratio (col. 16, lines 9-14).

Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made to use, to include aspect ratio in the coding attribute, in order to be able to reproduce the signal with the correct aspect ratio.

13. Consider claim 10 Nagata et al. and Terasaki et al. teach all claimed limitations as stated above, except wherein said coding attribute includes sampling frequency.

However, Fukuda et al. teaches except wherein said coding attribute includes sampling frequency (col. 16, lines 9-14).

Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made to use, to include video sampling frequency in the coding attribute, in order to facilitate the reception of the signal at the receiving end when transmitting data.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MISHAWN DUNN whose telephone number is (571)272-7635. The examiner can normally be reached on Monday - Friday 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on (571)272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MISHAWN DUNN/
Examiner, Art Unit 2621
April 10, 2009

/JAMIE JO VENT ATALA/
Examiner, Art Unit 2621